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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/7701,278	08/22/96	ANDERSON	D A-63770-17/RF

HM22/0914

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EXAMINER

HAYES, R

ART UNIT	PAPER NUMBER
1645	21

DATE MAILED: 09/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No. 08/701,278	Applicant(s) Anderson et al
Examiner Robert C. Hayes	Group Art Unit 1645

Responsive to communication(s) filed on Jun 22, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

Claim(s) 1, 2, and 4-7 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

Claim(s) _____ is/are allowed.

Claim(s) 1, 2, and 4-7 is/are rejected.

Claim(s) _____ is/are objected to.

Claims _____ are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The proposed drawing correction, filed on _____ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1645

DETAILED ACTION

Continued Prosecution Application

1. The request filed on 6/22/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/701278 is acceptable and a CPA has been established. An action on the CPA follows.
2. Applicant's arguments filed 6/22/99 have been fully considered but they are not deemed to be persuasive.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-2 & 4-7 are again rejected under 35 U.S.C. 102(a) as being anticipated by Saito et al., for the reasons made of record, and as follows.

In contrast to Applicants' arguments:

1) Paper No.3, filed 10/15/96, specifically states that Anderson, Saito and Greenwood are "Inventors".

Paper No.5, filed 1/13/97, specifically states that Sun is an "Inventor", in order to avoid abandonment of this Provisional Application for filing an incomplete response to a 10/15/96 notice of Filing Missing Parts. See Paper No.4 (filed 12/13/96).

Art Unit: 1645

Thus, Provisional Application, 60/023,280, filed July 25, 1996, which describes the invention of Group I (i.e., elected in Paper No. 8, filed 8/18/97) named Anderson, Saito, Greenwood and Sun as "Inventors", versus "Applicants", in which both Paper Nos. 3 and 5 were signed by Applicants' representative to avoid abandonment of this Provisional Application.

2) The Declaration under 37 CFR 1.132, filed 1/4/99 in accordance with *In re Katz*, remains insufficient to overcome the rejection of claims 1-2 & 4-7 as being anticipated by Saito et al., as set forth in the last Office action of 4/12/99 (Paper No.17), because the Provisional Application, 60/023,280 and the June 1995 *Molec. Cell. Neurosci.* article describing cloning of the polynucleotide encoding DRG11 using PCR (i.e., the same polynucleotide of Group I, restricted in Paper No. 6, filed 6/13/97) are one-in-the-same. This polynucleotide sequence is 100% identical to SEQ ID NO 1 (i.e., GenBank Accession No. U29174, submitted June 14 1995; see also pg. 291 of Saito et al., 2nd *pp*; as it relates to claims 1 & 4).

3) Since Applicants have declined changing the inventorship within the Provisional Application, the issue then becomes whether Green wood and Sun were "Inventors" of either the DRG11 protein or DRG11 antibody mentioned in the last paragraph on page 291 of the June 1995, Saito et al. *Molec. Cell. Neurosci.* publication, or who actually invented the instant invention, as indicated below. It is again noted that M.P.E.P., Section 201.04(e) specifically "provides a procedure for deleting the name of a person who was erroneously named as an inventor in a provisional application". It is further noted that "no statement of facts verified by

Art Unit: 1645

the person whose name is being deleted establishing that the error occurred without deceptive intention" has been provided by Applicants.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

Claims 1-2 & 4-7 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter.

As discussed above, Provisional Application, 60/023,280, filed July 25, 1996, named Anderson, Saito, Greenwood and Sun as "inventors", in which both Paper Nos. 3 and 5 were signed by Applicants' representative to avoid abandonment of the Provisional Application. Additionally, the June 1995 *Molec. Cell. Neurosci.* article describes cloning of the polynucleotide encoding DRG11 using PCR (i.e., the same polynucleotide of Group I, which was restricted in Paper No. 6, filed 6/13/97). This polynucleotide sequence is 100% identical to SEQ ID NO 1 (i.e., GenBank Accession No. U29174, submitted June 14 1995; see also pg. 291 of Saito et al., 2nd *pp*; as it relates to claims 1 & 4). Thus, because the Declaration under 37 CFR 1.132, filed 1/4/99 in accordance with *In re Katz*, stated that "[t]he work in the *MCB* publication that was contributed by Amy Greenwood and Qi Sun did not rise to the level of inventorship", the issue of who invented what is now raised.

Art Unit: 1645

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Robert Hayes whose telephone number is (703) 305-3132. The examiner can normally be reached on Monday through Thursday, and alternate Fridays, from 8:30 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

(RC)

Robert C. Hayes, Ph.D.
September 1, 1999


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SUPERVISORY PATENT EXAMINER
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